

Appl. No. : 09/782,588
Filed : February 12, 2001

REMARKS

Claims 1-4, 6, 7, 10-12, and 18-25 and 27 are presented for examination. Claims 5, 8, 9, and 13-17 and 26 are canceled, and Claims 1-4, 10-12, and 18-20 have been amended. Support for the amendments to Claim 1 and Claim 18 can be found on page 9, lines 35-38, and page 10, lines 1-24, for example. Accordingly, no new matter has been added. Reconsideration of the present case is respectfully requested.

Discussion of Rejection Under 35 U.S.C. § 102

The Examiner has rejected Claims 1-4, 6-7, 9-12, 18-20, and 23-25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,863,722 (Brenner). Applicants respectfully traverse because Brenner does not disclose each and every element of Claims 1-4, 6-7, 9-12, 18-20, and 23-25.

To be anticipatory under 35 U.S.C. § 102, a reference must teach each and every element of the claimed invention. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). “Invalidity for anticipation requires that all of the elements and limitations of the claim are found within a single prior art reference. ...There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

Claims 1-4, 6-7, and 9-12 are directed to microscope slide compositions that comprise first and second assay locations having discrete sites, wherein the assay locations are separated from each other by a physical border. Similarly, Claims 18-20 and 23-25 relate to methods of making microscope slide compositions comprising first and second assay locations having discrete sites, wherein the assay locations are separated from each other by a physical border.

Composite arrays, such as those claimed, have first and second assay locations so that one microscope slide can be used to test several different samples. Practitioners can utilize the multiple assay locations to quickly process and analyze more than one sample simultaneously.

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See Application, page 1, lines 9-10. As discussed in the specification, physical borders are placed around each assay location so that samples and reagents placed at one assay location do not spill over onto a different assay location. See Application, page 10, lines 1-24. Accordingly, Applicants' invention provides an efficient way to quickly analyze a series of desired samples. Specific configurations of compositions having multiple assay locations and physical borders are provided in Figures 1A-E.

In contrast to the pending claims, Brenner fails to teach or suggest microscope slide compositions having more than one assay locations. The compositions taught by Brenner are designed to perform a single assay, such as sorting and sequencing the polynucleotides of a single mixture. See column 2, lines 66 and 67, column 3, line 1. There is no discussion in this reference of using a microscope slide composition, having more than one assay locations, to analyze multiple biological samples. In addition to not teaching first and second assay locations, Brenner also fails to disclose the use of physical borders to separate different reactions on a composition. As Brenner does not teach or suggest the elements of Claims 1-4, 6, 7, 9-12, 18-20, and 23-25, it could not anticipate these claims. For this reason, Applicants respectfully request the withdrawal of this rejection.

Discussion of Rejection Under 35 U.S.C. § 103

The Examiner rejected Claims 1-4, 6-12, 18-20, 23-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over WO 98/40726 (Walt) in view of U.S. Patent No. 6,129,896 (Noonan) and U.S. Patent No. 6,248,521 (Van Ness). Furthermore, the Examiner rejected Claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Walt, Noonan and Van Ness, and further in view of U.S. Patent No. 6,306,643 (Gentalen).

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

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Applicants respectfully submit that the cited references fail to teach or suggest all of the elements of the rejected claims. Specifically, Claims 1-4, 6-12, 18-25, and 27 recite microscope slide compositions having first and second assay locations separated from each other by a physical border. In contrast to Applicants' claims, the Examiner has failed to cite any passages in Walt, Noonan, Van Ness or Gentalen that teach multiple assay locations separated by a physical border. Thus, Applicants respectfully submit that the Examiner has not shown that the above references, either alone or in combination teach each and every claim limitation.

Moreover, a skilled artisan would not be motivated to add physical borders to the teachings of Walt, Noonan, Van Ness or Gentalen. As discussed above, the purpose of the physical borders is to prevent the samples and reagents applied to one assay from mixing with the samples and reagents of another assay location. As the cited art fails to teach or suggest first and second assay locations, a skilled artisan would not be motivated to add a feature designed to ameliorate potential problems associated with more than one assay location. Specifically, there is no reason to keep samples and reagents separate from one another if the composition lacks multiple assay locations.

Thus, for all of the above reasons, Applicants respectfully request withdrawal of the rejections of Claims 1-4, 6-12, 18-20, 23-25, and 27 under 35 U.S.C. § 103, and allowance of the pending application.

CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410. If the Examiner finds any remaining impediment to the prompt allowance of those claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Respectfully submitted,

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Dated: 12/19/03

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